



81
Jd
6/10/03

**RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 2683
PATENT**

Customer No. 22,852
Attorney Docket No. 04329.2423

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Kentoku YAMAGUCHI et al.)
) Group Art Unit: 2683
Application No.: 09/665,687)
) Examiner: Brandon J. Miller
Filed: September 20, 2000)
)
For: COMMUNICATION TERMINAL)
AND CHANNEL CONNECTION)

RECEIVED

JUN 10 2003

Technology Center 2600

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR RECONSIDERATION AFTER FINAL

In reply to the Final Office Action of March 6, 2003, and pursuant to 37 C.F.R. § 1.116, Applicants request reconsideration in view of the following remarks.

REMARKS

In the Final Office Action dated March 6, 2003, the Examiner rejected claims 1-3 and 6-14 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,911,120 to Jarett et al. ("Jarett") in view U.S. Patent No. 6,112,088 to Haartsen ("Haartsen") and rejected claims 4-5 and 15-16 under 35 U.S.C. § 103(a) as unpatentable over Jarett in

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

view of Haartsen and further in view of U.S. Patent No. 6,449,484 to Grubeck et al. ("Grubeck"). Upon entry of this Amendment, claims 1-16 will remain currently pending.

Rejection of claims 1-3 and 6-14

As noted in the Final Office Action, the Examiner rejected claims 1-3 and 6-14 under 35 U.S.C. § 103(a) as unpatentable over Jarett in view of Haartsen. Applicants respectfully traverse the rejection.

Independent claim 1 relates to a communication terminal having a first radio unit and a second radio unit. A first channel establishing section uses the first radio unit to establish a first radio channel to a base station. A second channel establishing section uses a second radio unit to establish a second radio channel to another communication terminal. The first and second radio channels have first and second radio frequency bands, respectively. In the communication terminal, a control section then establishes a communication channel between a calling party and another communication terminal via the first radio channel and the second radio channel. Therefore, a communication channel can be established from the calling party through the communication terminal to another communication terminal.

For example, claim 1 recites "a control section configured to connect the first radio channel established by the first channel establishing section to the another communication terminal via the second radio channel established by the second channel establishing section, such that a communication channel between the calling party and the another communication terminal can be established via the second radio unit." The Examiner correctly admits that Jarett fails to teach such a feature. (See Final Office Action at page 2.) In particular, the Examiner acknowledges that Jarett does not

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

teach a control section, such that a communication channel can be established from a calling party through a communication terminal to another communication terminal. (Id.)

However, the Examiner alleges that it would have been obvious to combine Jarett with Haartsen to arrive at the features of claim 1. Applicants respectfully disagree.

Haartsen fails to cure the deficiencies of Jarett. In the Final Office Action, the Examiner asserts that Haartsen teaches a control for connecting a base station to another communication terminal over a first and second radio channel. (See Final Office Action at page 3.) Applicants respectfully submit that such a reading of Haartsen is incorrect.

Haartsen's mobile terminal establishes a first radio connection with a public land mobile telephone network to a calling party. (See Haartsen at col. 6, lines 9-22.) Haartsen's mobile terminal also includes a "controlling means" that establishes a secondary radio communication connection with a private radio communications network. (See Haartsen at col. 6, lines 40-43.) Haartsen's mobile terminal switches to the secondary radio connection, if the detected signal quality of the first connection falls below stored switching criteria. (See Haartsen at col. 6, lines 45-56.) Therefore, Haartsen teaches a mobile terminal that establishes redundant connections between itself and a calling party, not to another communication terminal.

Accordingly, Haartsen fails to teach a communication terminal that includes "a control section configured to connect the first radio channel established by the first channel establishing section to the another communication terminal via the second radio channel established by the second channel establishing section, such that a

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

communication channel between the calling party and the another communication terminal can be established via the second radio unit," as recited by claim 1. That is, Haartsen fails to teach a communication channel that is established from a calling party through the communication terminal to another communication terminal. Haartsen instead teaches a mobile terminal that establishes redundant connections between only itself and a calling party. (See Haartsen at col. 6, lines 40-56.) Since the redundant connections are for that same mobile terminal, Haartsen's mobile terminal does not establish a communication channel between a calling party and another communication terminal. Therefore, Haartsen does not teach a communication terminal that includes "a control section configured to connect the first radio channel established by the first channel establishing section to the another communication terminal via the second radio channel established by the second channel establishing section, such that a communication channel between the calling party and the another communication terminal can be established via the second radio unit," as recited by claim 1.

Accordingly, even if Jarett and Haartsen were properly combinable, the combination of Jarett and Haartsen would still fail to teach or suggest "a control section configured to connect the first radio channel established by the first channel establishing section to the another communication terminal via the second radio channel established by the second channel establishing section, such that a communication channel between the calling party and the another communication terminal can be established via the second radio unit," as recited by claim 1. Applicants therefore respectfully request reconsideration and withdrawal of the rejection of claim 1 and its respective dependent claims 2-3.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Independent claim 6 recites a channel connection method for a communication terminal that comprises, *inter alia*, connecting a first radio channel established through a first radio unit to another communication terminal via a second radio channel established through the second radio unit, such that a communication channel between calling party connected to a base station over the first radio channel and the another communication terminal can be established via the second radio unit. For reasons similar to those explained above, Jarett and Haartsen, alone or in combination, fail to teach or suggest such a feature. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection to claim 6 and its respective dependent claims 7-10.

Independent claim 11 recites a communication terminal. A radio channel establishing section establishes a radio channel to a radio communication device connected to a base station. A receiving section receives a telephone number over the radio channel. A ceasing section ceases the established radio channel. An originating section originates a call to a party with the telephone number that was received from the radio communication device. Therefore, the communication terminal may originate a call to a party based on a telephone number that was received from a radio communication device connected to a base station.

The Examiner correctly acknowledges that Jarett fails to teach or suggest receiving a telephone number over a radio channel or ceasing an established radio channel and originating a call to a party with a received telephone number. (See Final Office Action at pages 7-8.) However, the Examiner alleges that it would have been

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

obvious to combine Jarett and Haartsen to arrive at the features of claim 11. Applicants respectfully disagree.

Haartsen fails to cure the deficiencies of Jarett. For example, Haartsen also fails to teach or suggest, a communication terminal having an originating section that originates a call to a party with a received telephone number, as recited in claim 11. Haartsen instead teaches base stations that originate a call based on a received telephone number and a location of the mobile terminal assigned the received telephone number. (See Haartsen, col. 5, lines 42-53.) Although, Haartsen's mobile terminal may receive a telephone number, the telephone number is received only from a base station of a public land mobile network or a private radio communication network, not a communication terminal. (See Haartsen, col. 6, lines 50-65.)

In contrast, claim 11 recites, for example, a communication terminal having "an originating section configured to originate a call to a party with the received telephone number." As noted, the telephone number is received from a radio communication device that is connected to a base station. Haartsen instead teaches a mobile terminal that receives telephone numbers from base stations, not a radio communication device connected to a base station. Therefore, Haartsen fails to teach or suggest a communication terminal having an originating section that originates a call to a party with a received telephone number, as recited in claim 11.

Accordingly, even if Jarett and Haartsen were properly combinable, the combination of Jarett and Haartsen would still fail to teach or suggest the combination of features recited in claim 11. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection to claim 11.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Independent claim 12 recites a communication terminal having a first radio unit configured to make radio communication with a base station over a first radio channel having a first radio frequency band, and a second radio unit configured to make radio communication with another communication terminal by using a second radio channel having a second radio frequency band. A receiving section receives information from the base station over the first radio channel. A sending section then sends the received information to the another communication terminal over the second radio channel while the receiving section receives the information over the first radio channel.

For reasons similar to those explained above, Jarett and Haartsen, fail to teach, for example, a communication terminal having a sending section that sends received information to another communication terminal over a second radio channel while a receiving section receives the information over a first radio channel. Accordingly, even if Jarett and Haartsen, were properly combinable, the combination of Jarett and Haartsen would still fail to teach or suggest the combination of features recited in claim 12. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 12 and its respective dependent claims 13-14.

Rejection of claims 4-5 and 15-16

In the Final Office Action, the Examiner rejected claims 4-5 and 15-16 under 35 U.S.C. § 103(a) as unpatentable over Jarett in view of Haartsen and further in view of Grubeck. Applicants respectfully traverse this rejection.

Claims 4-5, through their dependence from claim 1, recite a communication terminal that includes, *inter alia*, "a control section configured to connect the first radio channel established by the first channel establishing section to the another

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

communication terminal via the second radio channel established by the second channel establishing section, such that a communication channel between the calling party and the another communication terminal can be established via the second radio unit," as recited by claim 1.

As explained above, Jarett and Haartsen, alone or in combination, fail to teach or suggest such a feature. Furthermore, Grubeck fails to cure the deficiencies of Jarett and Haartsen.

Grubeck teaches a base station that allocates a channel to a group of mobile stations based on their output power demands. (See Grubeck, col. 5, lines 50-60.) Mobile stations that have similar output power demands are allocated the same channel. (Id.) However, a base station that allocates the same channel to a group of mobile stations, as taught by Grubeck, is not the same as a communication terminal having a control section configured to connect a first radio channel to another communication terminal via a second radio channel, such that a communication channel between the calling party and the another communication terminal can be established, as recited in claim 1. Therefore, Grubeck also fails to teach or suggest at least this feature of claim 1.

Accordingly, even if Jarett, Haartsen, and Grubeck, were properly combinable, the combination would still fail to teach or suggest "a control section configured to connect the first radio channel established by the first channel establishing section to the another communication terminal via the second radio channel established by the second channel establishing section, such that a communication channel between the calling party and the another communication terminal can be established via the second

radio unit," as recited by claim 1. Applicants therefore request reconsideration and withdrawal of the rejection of dependent claims 4-5.

Claims 15-16, through their dependence from claim 12, recite a communication terminal that includes, *inter alia*, "a sending section configured to send the received information to the another communication terminal over the second radio channel while the receiving section receives the information over the first radio channel." For reasons similar to those explained above, Jarett, Haartsen, and Grubeck, alone or in combination, fail to teach such a feature. Therefore, Applicants also request reconsideration and withdrawal of the rejection of dependent claims 15-16.

CONCLUSION

Applicants respectfully request that this Request for Reconsideration under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-16 in condition for allowance. Applicants submits that this Request for Reconsideration does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Request should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of this Request for Reconsideration would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submits that the entry of this Request for Reconsideration would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

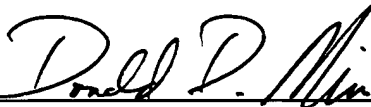
In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Request for Reconsideration, the Examiner's reconsideration, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 5, 2003

By: 
Donald D. Min
Reg. No. 47,796

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com